

## REMARKS/ARGUMENTS

Claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78 and 82-84 are currently pending in the application. Claims 20-29, 50-65 and 85-94 have been withdrawn from consideration with traverse in response to a restriction requirement. Claims 2-3, 14-16, 31-32, 44-46, 67-68 and 79-81 have been canceled without prejudice.

Applicant respectfully requests a three-month extension of time to extend the due date from May 3, 2009 to August 3, 2009. A credit card authorization for the required fees is being submitted herewith. The Commissioner is hereby authorized to charge any additional fees, or credit any refunds, to Chalker Flores, LLP's Deposit Account No. 50-4863.

Claims 1, 4-13, 15-19, 30, 33-43, 45-49, 66, 69-78, 80-84 were rejected in the Office Action mailed February 3, 2009 (hereinafter referred to as "Office Action"). In view of the following remarks and amendments, applicant respectfully requests a timely Notice of Allowance be issued in this case.

### *Response to Remarks*

The Office Action indicated that the identifiers for claims 67-68 and 81 were incorrect. Applicant respectfully submits that the identifiers for claims 67-68 have been corrected and claims 81 has been canceled.

### *Response to Arguments*

The Office Action indicated that "it would be prima face obvious to one having ordinary skill in the art at the time the invention was made to modify Mistr, Jr. to include said two or more available power sources (Fig. 1 items 35 and 36) . . . because . . . applying the known technique . . . would have yielded predicable results and resulted in an improved system." (page 6, lines 16-22).

MPEP § 2143.D. states that to reject a claim based on applying a known technique to a known device ready for improvement to yield predictable results, the Office Action must articulate the following:

(1) a finding that the prior art contained a "base" device (method, or product) upon which the claimed invention can be seen as an "improvement;"

(2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product);

(3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Applicant respectfully submits that the Office Action does not articulate the required findings in such a way as to result in “an improved system” as recited in claims 1, 30 and 66 as previously presented or as currently amended.

More specifically, applicant respectfully submits that: (1) Mistr does not disclose the “base” device recited in claims 1, 30 and 66; and (2) adding “a power generator/mechanical source” is not the technique being applied in claims 1, 30 and 66; (3) adding “a power generator/mechanical source” to Mistr does not yield the “improved system” recited in claims 1, 30 and 66. Based on the claims previously presented:

- (1) Mistr does not disclose the “base” device because:
  - a. the identified power sources (Figure 1 items 35 (generator) and 36 (AC power source)) are electrical power sources instead of mechanical power sources,
  - b. the “Load” (Figure 1) is an electrical load instead of a device connected to the mechanical sources via one or more couplings,
  - c. the “Load” (Figure 1) is only connected to electrical sources (Figure 1 items 35 (generator) and 36 (AC power source)) instead of being connected to the mechanical sources via one or more couplings;
- (2) adding “a power generator/mechanical source” is not the technique being applied because operating a device connected to two or more mechanical sources via one or more couplings using the steps/criteria recited in the claims is not a known technique as of the earliest filing date of the present application; and
- (3) applying “a power generator/mechanical source” to Mistr does not yield the “improved system” recited in claims 1, 30 and 66 because of the deficiencies stated above in (2) and (3).

As a result, applicant respectfully submits that claims 1, 30 and 66 as previously presented are patentable over the cited references in accordance with *KSR International Co. v. Teleflex Inc.*

Claims 1, 30 and 66 have been amended to further clarify the claimed invention. Applicant respectfully submits that the foregoing distinctions also apply to claims 1, 30 and 66 as amended. As a result, applicant respectfully submits that independent claims 1, 30 and 66, as amended and dependant claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84, as

amended, are patentable over the cited references in accordance with *KSR International Co. v. Teleflex Inc.*

***Claim Rejections under 35 U.S.C. § 103(a)***

Claims 1, 4-13, 15-19, 30, 33-43, 45-49, 66, 69-78, 80-84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mistr, Jr. (U.S. Patent No. 6,153,943) in view of Aasen, et al. (U.S. Patent No. 4,802,100). Applicant respectfully submits that claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, 82-84, as amended, are patentable over the cited references for at least the reasons described below.

***Claims 1, 30 and 66***

Applicant respectfully submits that the cited references do not disclose, teach or suggest all of the elements recited in claims 1, 30 and 66, as amended. More specifically, applicant respectfully submits that Mistr does not disclose, teach or suggest at least the following elements recited in claims 1, 30 and 66, as amended:

- (1) a shaft-driven device connected to the two or more available power sources via one or more couplings and one or more drive shafts, wherein the two or more available power sources comprise two or more mechanical sources;
- (2) wherein the two or more mechanical sources are selected from the group consisting of one or more engines, one or more motors, one or more motor/generators and one or more turbines;
- (3) performing the claimed steps to select and switch the shaft-driven device to the selected mechanical source using the one or more couplings;
- (4) determining whether it is profitable to switch the shaft-driven device to the selected power source based on a projected potential revenue and a projected cost associated with switching to the selected power source, a time period and one or more guidelines; and
- (5) sending one or more signals to the one or more couplings to physically switch the shaft-driven device to the selected power source.

First, applicant respectfully submits that Mistr does not disclose, teach or suggest a shaft-driven device connected to the two or more available power sources via one or more couplings and one or more drive shafts, wherein the two or more available power sources comprise two or more mechanical sources because:

- (a) the identified power sources (Figure 1 items 35 (generator) and 36 (AC power source)) in Mistr are electrical power sources instead of mechanical power sources;

- (b) the "Load" (Figure 1) in Mistr is an electrical load instead of a shaft-driven device connected to the mechanical sources via one or more couplings and one or more drive shafts; and
- (c) the "Load" (Figure 1) in Mistr is only connected to electrical sources (Figure 1 items 35 (generator) and 36 (AC power source)) instead of a shaft-driven device being connected to the mechanical sources via one or more couplings and one or more shafts.

As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Second, applicant respectfully submits that Mistr does not disclose, teach or suggest that the two or more mechanical sources are selected from the group consisting of one or more engines, one or more motors, one or more motor/generators and one or more turbines because the selected power sources are both electrical (Figure 1 items 35 (generator) and 36 (AC power source)). Mistr discloses a motor/generator 35, but the motor portion having a shaft is not connected to the Load. In addition, Mistr discloses turbines 17 and 23, but the shaft 10 is not connected to the Load. Mistr does not disclose engines or motors. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Third, applicant respectfully submits that Mistr does not disclose, teach or suggest performing the claimed steps to select and switch the shaft-driven device to the selected mechanical source using the one or more couplings because there are no couplings connected to the Load and the Load is not a shaft-driven device. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Fourth, applicant respectfully submits that Mistr does not disclose, teach or suggest determining whether it is profitable to switch the shaft-driven device to the selected power source based on a projected potential revenue and a projected cost associated with switching to the selected power source, a time period and one or more guidelines because the portions of Mistr cited in the Office Action do not disclose a projected revenue or a projected cost associated with switching or a time period. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Fifth, applicant respectfully submits that Mistr does not disclose, teach or suggest sending one or more signals to the one or more couplings to physically switch the shaft-driven device to the selected power source because the signals cited in Mistr only purchase power from different electricity suppliers (col. 13, lines 37-44). Such a signal is not sent to one or more couplings to physically switch the shaft-driven device to a different mechanical source. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

In addition, applicant respectfully submits that modifying Mistr to correct all of the foregoing deficiencies would render Mistr “unsatisfactory for its intended purpose” (MPEP § 2143.01(V)) and “change the principle of operation” (MPEP § 2143.01(VI)) because Mistr is designed to “generate conditioned electrical power” (Abstract, lines 4-5) and the claimed invention provides mechanical power to a shaft-driven device. As a result, “there is no suggestion or motivation to make the proposed modification” (MPEP § 2143.01(V)) and “the teachings of the references are not sufficient to render the claims *prima facie* obvious” (MPEP § 2143.01(VI)). Moreover, it would not be obvious to modify Mistr under *KSR International Co. v. Teleflex Inc.* for at least the reasons stated above in the previous section.

Finally, applicant respectfully submits that Aasen does not cure all of the foregoing deficiencies of Mistr. As a result, applicant respectfully submits that Mistr and Aasen, either alone or in combination, do not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

For at least the reasons stated above, applicant respectfully submits that claims 1, 30 and 66, as amended, are not obvious over Mistr in view of Aasen and are, therefore, allowable under 35 U.S.C. § 103(a). Applicant respectfully requests that the rejection of claims 1, 30 and 66 be withdrawn.

***Claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84***

Applicant respectfully submits that claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84, as amended, depend from claims 1, 30 and 66 which are allowable for the reasons stated above, and further distinguish over the cited references. Claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84 are, therefore, allowable under 35 U.S.C. § 103(a). Accordingly, applicant respectfully requests that any rejection of claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84 be withdrawn.

In addition and with respect to claims 17, 47 and 82, applicant respectfully submits that Mistr does not disclose, teach or suggest that the Load is selected from a group consisting of a shaft-driven compressor and a shaft-driven pump because the Load is electrically driven. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 17, 47 and 82, as amended. Accordingly, applicant respectfully requests that any rejection of claims 17, 47 and 82 be withdrawn.

***Conclusion***

For the reasons set forth above, applicant respectfully requests reconsideration by the examiner and withdrawal of the rejections. Applicant submits that claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, 82-84, as amended, are fully patentable. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the examiner has any questions or comments, or if further clarification is required, it is

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Amdt dated Aug. 3, 2009  
Reply to Office Action of Feb. 3, 2009

requested that the examiner contact the undersigned at the telephone number listed below.

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Respectfully submitted,  
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